

REMARKS

The Office Action mailed November 12, 2008 has been carefully considered. Within the Office Action Claims 1-32 have been rejected. The Applicants have amended Claims 1-30 and have cancelled Claims 31 and 32. The Applicants reserve the right to further pursue the cancelled claims in a continuation and/or divisional application as well as for appeal purposes. In addition, the Applicants have added new Claims 33 and 34. No new matter has been added. Reconsideration in view of the following remarks is respectfully requested.

Priority

Although Applicants thank the Examiner for his acknowledgement of the claim of priority, Applicants would like to point out that a certified copy of European Application No. 04100847.9 is currently accessible in PAIR under the mail room date of August 14, 2006.

Rejection under U.S.C. § 102

Claims 1, 2, 4-6, 22 and 28 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,599,272 to Hjertman et al. (hereinafter "Hjertman"). The Applicants respectfully traverse.

According to the M.P.E.P., a claim is anticipated under 35 U.S.C. § 102(a), (b) and (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Applicants' specification describes an electronic injection device which includes a supporting sleeve 42 which receives a cartridge 4. An actuator assembly 41 moves the sleeve 42 and cartridge 4 upward and downward along axis A between a top limit position and a bottom limit position. The device includes a through opening 30 which accepts a needle housing 31,

whereby the needle housing 31 includes a needle support 33 and a needle 25. The needle assembly 32, and thus the needle 25, is inserted into the opening 30 to couple the needle assembly 32 to the cartridge 4 when the cartridge 4 is at its bottom limit position. The device includes a retaining element 60 that automatically locks the needle housing 31 at the opening 30 and maintains the needle support 33 in the locked position to allow the cartridge 4 to engage the needle support 33. The retaining element 60 is also configured to automatically release the needle support 33 from the opening 30 as the cartridge moves upward toward the top limit position, whereby the needle support 33 also moves upward inside the body along with the cartridge 4. This is advantageous from a safety point-of-view as the retaining element maintains the needle at the opening 30 when the cartridge is lowered to engage the needle, thereby preventing untimely removal of the needle by the user. Another safety advantage of the retaining element 60 is that it automatically releases the lock on the needle support 33 when the cartridge moves upward, thereby withdrawing the needle from exposure and storing it inside the housing to prevent accidental puncturing.

In contrast, Hjertman discloses a fully mechanical injector device that has a button 230 that, when pressed down, moves an injection sleeve 250 which causes the needle 223 to move outward out of the housing. Hjertman includes a set of knobs 229 attached to the injection sleeve 250 that can be pulled back away from the opening 211 to retract the needle 223 back inside the housing. Hjertman discloses a button hook 234 which has a rear hook 235 which engages the button 230 and the knobs 229. As disclosed in Hjertman, the hooks 234 and 235 act to cause the button 230 to move upward to an action position in response to the knobs 229 being moved away from the opening 211. (Hjertman, Col. 20, Lines 50-58). There is no disclosure in Hjertman that the hooks 234, 235 selectively lock the needle assembly at a locked position at the opening, as recited in Claim 1. Additionally, Hjertman does not disclose that the hooks 234, 235 maintain

the needle assembly at the locked position as the container 230 is connected to the needle assembly. In other words, there is no mechanism in Hjertman for releasably holding the needle assembly 223 in a position fixed relative to the housing 210 as the medication container 220 is moved from the retracted position to the outer position. Therefore, the connection of the needle assembly 223 to the medication container 220 can be made only manually, when the medication container 220 is in the outer position. This is clear from the description, column 20, lines 39-45 in which it is stated, “[a] first user step is then to attach the needle 23 at the exposed container front 222 and remove any shield present.”

Claim 1 recites *inter alia* a retaining means configured to selectively lock said needle assembly **at a locked position at said through opening**, wherein during displacement of said medication container towards said contact surface from a first operating position withdrawn inside said housing and in which said medication container is not connected to said needle to a second operating position said medication container is connected to said needle assembly, said retaining means maintains **said needle assembly at said locked position**. (emphasis added). As stated above, there is no disclosure in Hjertman that the hooks 234, 235 selectively lock the needle assembly at a locked position at the opening, as recited in Claim 1. Further, Hjertman does not disclose that the hooks 234, 235 maintain the needle assembly at the locked position as the container 230 in Hjertman is connected to the needle assembly. For at least these reasons, Hjertman does not teach each and every element/limitation in Claim 1. Accordingly, Claim 1 is distinguishable over Hjertman.

Claims 4-6, 22 and 28 have also been rejected in light of Hjertman. However, Claims 4-6, 22 and 28 are dependent on Independent Claim 1. As stated above, Claim 1 is allowable over Hjertman. Accordingly, Claims 4-6, 22 and 28 are allowable for being dependent on an allowable base claim.

First Rejection under 35 U.S.C. § 103

Claims 3, 10-13, 15-16 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hjertman in view of U.S. Patent No. 6,171,276 to Lippe et al. (hereinafter “Lippe”). Claims 7-9 and 29 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hjertman in view of U.S. Patent Publication No. 2005/0090781 to Baba et al. (hereinafter “Baba”). Claim 30 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hjertman in view of Baba, in further view of U.S. Patent Publication No. 2007/0142776 to Kovelman et al. (hereinafter “Kovelman”). Claims 23-27 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hjertman in view of U.S. Patent Publication No. 2005/0107923 to Vanderveen. Claims 14, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hjertman in view of Lippe, in further view of Baba. Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hjertman in view of Lippe, in view of Baba, in further view of U.S. Patent Publication No. 2003/00652587 to Spohn et al. (hereinafter “Spohn”). Claim 21 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hjertman in view of Lippe, in further view of Spohn. These rejections are respectfully traversed.

The above dependent claims are dependent on Independent Claim 1. As stated above, Claim 1 is allowable over Hjertman. Accordingly, the dependent claims are allowable for being dependent on an allowable base claim.

New Claims

The Applicants have added new Claims 33 and 34 to the present application. The Applicants believe that new Claims 33 and 34 are fully supported by the specification and no new matter has been added. Allowance of new Claims 33 and 34 is respectfully requested.

Conclusion

It is believed that this reply places the above-identified patent application into condition for allowance. Early favorable consideration of this reply is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-3557. A one month extension fee accompanies this reply.

Respectfully submitted,

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